

## REMARKS

This Amendment & Response amends claims 1, 25 and 26, cancels no claims, and adds no new claims. Claims 1-5, 7-18, 25 and 26 remain pending in the application.

### *Direct Response to the Examiner's Opening Remarks*

The claims have been amended to clarify that selection criteria is input directly into each controlled unit by a user, as opposed to Del Castillo where any selection criteria is input into each controlled unit by the central control device. This results in a significant difference as the method and system of Del Castillo places the owner of the control unit in command of all controlled devices in communication with the control unit, while the method and system of the Present Claimed Invention places the owner of each controlled device in command of his/her controlled device even though the controlled device is in communication with a control unit under the control of someone else.

### *Objections/Rejections Under 35 U.S.C. §102 and §103*

**1.0** *The Examiner has rejected claims 1-5, 7-12, 14-18, 25 and 26 as anticipated by Del Castillo (United States Patent 6,742,188).*

### SUMMARY OF CITED REFERENCE

**Del Castillo** (United States Patent No. 6,742,188) discloses a method and system for encoding addressable control data into the horizontal overscan area of a video signal for controlling operation of a controlled device associated with the encoded address. The control data is concatenated with the video signal, thereby permitting the controlled device, such as a wireless mechanical character, to behave as characters in a scene defined by the programming information of the video signal. Del Castillo discloses that the system can include a plurality of controlled devices under common control by a central control device, with control conducted in accordance with control data received from the video signal and control data input into the central control device by a user.

## SUMMARY OF CLAIMED INVENTION

The Present Claimed Invention is a device, system and method for selectively providing human perceptible indicia in synchronization with a video program.

The device (claims 1-5 and 7-18) includes (A) a base station, housing (i) a communications port to receive a video input signal of a video program, (ii) a central processing unit for detecting control data embedded in a received video input signal, and (iii) a wireless transmitter module in communication with the central processing unit, (B) a plurality of wireless receiver units remote from said base station, (C) an interface device in individual communication with each wireless receiver unit for allowing user input of selection criteria directly into each wireless receiver unit separate and independent from any selection criteria input into the central processing unit or into other wireless receiver units, and (D) indicia attached to each wireless receiver unit. The central processing unit transmits detected data, translated as necessary to effect communication with each wireless receiver unit, through the wireless transmitter module. The indicia attached to each wireless receiver unit is selectively activated in response to data received from the control processing unit based upon selection criteria input into each wireless receiver unit by a user.

The system (claim 26) includes (i) means for embedding data into a broadcast signal of the video program, (ii) means for transmitting the broadcast signal and embedded data, (iii) means for receiving the broadcast signal and embedded data, (iv) means for detecting the data embedded in the broadcast signal; (v) means for transmitting the detected data as received or in translated form; (vi) means for receiving the transmitted detected data at a plurality of destination locations remote from where the broadcast signal was received and the activation signal was transmitted; (vii) means for receiving individually selected user input selection criteria at each destination location; and (viii) means for selectively activating the indicia at one or more destination locations in response to the received detected data based upon selection criteria input at each destination location.

The method (claim 25) includes the steps of (i) embedding data in the broadcast signal of a video program, (ii) transmitting the broadcast signal, (iii) receiving the broadcast signal at a remote location, (iv) detecting the data embedded in the broadcast signal, (v) transmitting the detected data as received or in translated form; (vi) receiving the transmitted detected data at a plurality of destination locations remote from where the broadcast signal was received and the activation signal was transmitted; (vii) receiving individually selected user input selection criteria at each destination location; and (viii) selectively activating the indicia at one or more destination locations in response to the received detected data based upon selection criteria input at each destination location.

#### LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. See, Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." Atlas Powder Co. v. E.I. duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

#### *DEL CASTILLO DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION*

Del Castillo discloses a method and system for addressed based control of a plurality of controlled devices by a common control unit in concatenation with programming presented by a video signal using control data embedded within the video signal and user defined control data input into the control unit. In contrast, the Present Claimed Invention is directed to a method and system for control of a plurality of controlled devices by a common control unit in concatenation with programming presented by a video signal using control data embedded within the video signal and user defined control data input into each controlled device. Del Castillo does NOT

disclose, teach or suggest selective activation of individual controlled devices based upon *selection criteria input into each of the controlled devices*. In other words, the method and system of Del Castillo places the owner of the control unit in command of all controlled devices in communication with the control unit, while the method and system of the Present Claimed Invention places the owner of each controlled device in command of his/her controlled device even though the controlled devices are in communication with a common control unit.

By way of nonlimiting example, Del Castillo discloses a method and system wherein a guest, who happens to be a Green Bay Packers fan, who brings her controlled device bearing the Packers logo to a football party could have her controlled device remain silent when the Packers score but scream "POINTS ON THE BOARD" whenever the opponent scores because her controlled device is under the influence and control of the host's control unit and the host happens to be a Vikings fan who has input selection data into the control unit to generate such output from the Packer Fan's controlled device. In contrast, the method and system of the Present Claimed invention allows the guest to remain in control of her controlled device (e.g., the Packer Fan's controlled device plays the Green Bay Packers Fight Song whenever the Packers score) even though her controlled device is receiving data signals through the control unit of a Vikings fan because the user input selection criteria controlling her controlled device was input by her directly into her controlled device rather than by the host into the control unit.

Withdrawal of this rejection is respectfully requested.

**2.0** *The Examiner has rejected claim 13 as obvious over Del Castillo (United States Patent 6,742,188) in view of Yuen et al. (United States Patent 6,668,133).*

#### SUMMARY OF CITED REFERENCE

**Del Castillo** (United States Patent No. 6,742,188) discloses a method and system for encoding addressable control data into the horizontal overscan area of a video signal for controlling operation of a controlled device associated with the encoded address. The control data is concatenated with the video signal, thereby permitting the controlled device, such as a wireless mechanical character, to behave as characters in a scene defined by the programming

information of the video signal. Del Castillo discloses that the system can include a plurality of controlled devices under common control by a central control device, with control conducted in accordance with control data received from the video signal and control data input into the central control device by a user.

Yuen et al. (United States Patent No. 6,668,133) discloses a method and apparatus of using digital codes (I codes) to program channel, date, time and length data (CDTL data) into a video recording unit.

#### LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re VaeckU, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

As to the first criteria, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01. "[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR Int'l v. Teleflex, Inc., 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396

(2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006); *see also* DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) ("Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"); In re Hoeschele, 406 F.2d 1403, 1406-07, 160 USPQ 809, 811-812 (CCPA 1969) (" [I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom..."). The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the art to combine the elements" in the manner claimed. KSR, 127 S.Ct. at 1731, 81 USPQ2d at 1389.

*DEL CASTILLO AND YUEN ET AL. DO NOT DISCLOSE EACH AND EVERY  
ELEMENT OF THE CLAIMED INVENTION*

As stated above, in connection with the rejection of claims 1-5, 7-12, 14-18, 25 and 26 as anticipated by Del Castillo, Del Castillo discloses a method and system for addressed based control of a plurality of controlled devices by a common control unit in concatenation with programming presented by a video signal using control data embedded within the video signal and user defined control data input into the control unit. In contrast, the Present Claimed Invention is directed to a method and system for control of a plurality of controlled devices by a common control unit in concatenation with programming presented by a video signal using control data embedded within the video signal and user defined control data input into each controlled device. Del Castillo does NOT disclose, teach or suggest selective activation of individual controlled devices *based upon selection criteria input into each of the controlled devices*. Yuen et al. is silent as to these aspects and features.

Withdrawal of this rejection is respectfully requested.


### CONCLUSION

Applicant respectfully submits that all pending claims (claims 1-5, 7-18, 25 and 26) are in condition for allowance.

Respectfully submitted,

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By

  
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